

REMARKS

Claims 1-2, 4-6, 9, 11, 12, 16, 20, 21, 23 remain pending in this application.

Claims 20, 21 and 23 have been withdrawn from consideration.

Claim 12 has been amended to incorporate the subject matter of now cancelled Claims 13 and 14.

Claims 3, 7, 8, 10, 13, 14 and 15 have been cancelled without prejudice. Claims 17-19 and 22 were cancelled in response to a previous action.

REJECTIONS UNDER 35 U.S.C. 103(a)

Claims 1 and 16 are improperly rejected as being unpatentable over Sanoff in view Thomas and further in view of Bayer.

The Office acknowledges that “Sanoff fails to expressly disclose... (e) preparing an invitation for each candidate, which includes an incentive to respond [to the survey form]” The Office relies upon Thomas to provide such a teaching.

The Office states Thomas discloses “...offering incentives to user to participate in the survey system.” However this is not a teaching to respond to the survey as required in the claims. In the Office’s cited passages, Thomas states:

“Potential survey participants register electronically via a computer if they desire to participate in surveys. To motivate computer users to become registered participants, incentives can be provided. Suitable incentives can vary widely. For example, the incentives might include sweepstakes offer, free services, money (credit card debit, savings deposit, money

market deposit), coupons, frequent flier miles, and the like;”
[0029]

and

“Preferably, advertising, incentives and referrals motivate individuals to seek to register to participate in surveys. The incentives may include one or more of money, sweepstakes, drawing, services, etc.” [0073]

These passages are quite clear that the incentive is directed to registering and not to responding to the survey as required in the claims. Without a teaching of all the elements between the combined references a *prima facie* case of obviousness cannot be made. Sanoff, Thomas and Bayer alone or in combination fail to teach the limitation of providing an incentive to respond to the survey. Therefore, the rejection of Claims 1 and 16 is improper and must be withdrawn.

With respect to Claim 16, the combination of Sanoff, Thomas and Bayer also fails to provide a teaching for providing a hyperlink with the invitations as will be discussed below with respect to Claim 2.

Claims 2, 4-6, 9, 11 and 12 are improperly rejected as being unpatentable over Sanoff in view of Thomas.

Regarding Claim 2, the Office acknowledges that Sanoff fails to “disclose ... (e) e-mailing each candidate ...a hyperlink to the survey form”. The Office references no art to provide this teaching.

The Office states that “Thomas discloses ... inviting the customer to take the survey through e-mailing, and providing user password and ID information along with the survey invitation”. No mention of Thomas disclosing a hyperlink to the survey in the invitation is made by the Office. This is, however for good reason, as nowhere in Thomas is a hyperlink disclosed.

Without a teaching of all the elements between the combined references a *prima facie* case of obviousness cannot be made. Sanoff and Thomas, alone or in combination, fail to teach the limitation of providing a hyperlink to the survey, nor does the Office even contend they do in the rejection. Therefore, the rejection of Claim 2 is improper and must be withdrawn.

The rejections of Claims 4-6, 9, 11 and 12 are also improper as described above as they depend from Claim 2. In addition the rejections of these claims are also improper for the following reasons:

Regarding dependent Claim 4, the Office states Sanoff discloses customizing a survey form using information from a database. The Applicant cannot find any teaching in Sanoff of this customizing of the survey form. The only customization described in Sanoff is a customization of brochures based on information from the database and not a survey as required in Claim 4.

Therefore the rejection of Claim 4 is improper and must be withdrawn.

Regarding dependent Claim 5, the Office states that Sanoff discloses the survey form is customized with graphics as a function of pre-selected candidate information in the database. Again, the Applicant fails to find any teaching in Sanoff of customizing the survey form with graphics based on information from the database. It is telling that there is not even a mention of graphics, pictures, or drawings in Sanoff.

Therefore the rejection of Claim 5 is improper and must be withdrawn.

Regarding dependent Claim 6, the Office states that the type of information is non-functional and thus irrelevant. The Office is incorrect. The Office has clearly misread *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983). The type of information used to customize the survey form directly effects the customization and the response to the survey, thus there is clearly a functional relationship. For example, selecting a wife based on extracurricular activities would likely lead to a different wife than selecting one based on looks, therefore the type of information is functional to the claimed method steps.

The Office has provided no reasons why the type of information is non-functional other than a conclusory statement and thus has not met the required burden.

The rejection of Claim 6 is improper and must be withdrawn.

Regarding dependent claim 9, the Office states that Sanoff and Thomas disclose a unique identifier is locked out upon completion of the survey to thereby prevent multiple surveys from the same candidate and alludes to (one-time use programming). The

Applicant has found no disclosure of locking out the unique identifier or of “one-time use programming” nor has the Office provided a specific reference. The Office has failed to meet its burden in establishing a *prima facie* case of obviousness.

The rejection of Claim 9 is improper and must be withdrawn.

Regarding dependent Claim 11, the Office relies upon Sanoff in view of Schillewaert however the stated rejection is based on Sanoff in view of Thomas. The rejection is improper on its face and thus must be withdrawn.

The Office improperly uses Thomas in an attempt to correct the acknowledge deficiency in Sanoff; however, nowhere does Thomas disclose the sending of an email from a named individual at an email address which includes an institution’s name to each candidate. Therefore, the rejection is improper and must be withdrawn.

Regarding Claim 12¹. The Office states that Sanoff and Thomas disclose including the real time monitoring of a website; updating a separate reporting website indicative of cumulative activity of all candidates, and that the reporting website includes the number of candidates responding to each question on the survey. The Office has failed to provide a specific citation for each of these conclusions. Furthermore, the applicant has been unable to find such teaching in either Sanoff or Thomas. Neither reference discloses a separate website and neither reference discloses real time monitoring. The only disclosure in Thomas for relaying results is through email and

¹ Includes the subject matter of Claims 13 and 14, as amended.

there is no disclosure of a website or survey in Sanoff. The Office has clearly failed to meet its burden in establishing a *prima facie* case of obviousness.

The rejection is improper and must be withdrawn.

CONCLUSION

The Office has failed to provide a *prima facie* case of obviousness. Each element recited in the claims has not been met by the references alone or in combination. The Applicant requests withdrawal of the rejections, and if the rejections are maintained, an element by element accounting of the claim terms and specific references relied upon in the cited art.

If the Examiner has any questions relating to this response or the application in general she is respectfully requested to contact the undersigned so that prosecution may be expedited.

Application Serial No.: **09/931,749**
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If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to **Deposit Account No. 04-1679**.

Respectfully submitted,

/mcc/

Mark C. Comtois

Reg. No. 46,285

Duane Morris, LLP
1667 K Street, NW
Suite 700
Washington, DC 20006-1608
Telephone: (202) 776-7800
Telecopier: (202) 776-7801

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